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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,689	06/27/2001	Shigeyoshi Hirashima	450100-03261	6422
20999	7590	09/05/2006	EXAMINER	
<b>FROMMER LAWRENCE &amp; HAUG</b> 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151				POON, KING Y
		ART UNIT		PAPER NUMBER
				2625

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/894,689	HIRASHIMA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	King Y. Poon	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 June 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3,6-8 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) 3,8 and 13 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,6,7,11 and 12 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 June 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

### **DETAILED ACTION**

1. Claims 3, 8, 13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6/23/2006.
2. Applicant's election with traverse of the restriction requirement in the reply filed on 6/23/2006 is acknowledged. The traversal is on the ground(s) that until now, the examiner has no difficulty in examining all of the claims in this application. This is not found persuasive because:
  - a) the application is originally examined by examiner Pendergrass.
  - b) Since the applicant is claiming a different invention (see amendment filed on 11/5/2005, and advisory action mailed on 11/30/2005), the examiner would required a new search for the newly claimed invention and in fact the examiner found new references directed to the now elected species. Therefore, the examiner has no difficulty of examining all of the species of the original filed invention does not mean the examiner has no difficulty of examining all of the species of the newly amended invention.
  - c) as a matter fact, the examiner has conducted a complete, detail and time consuming search for the elected species and located the best reference for the elected species and it appears that the newly located prior art is not the best reference for the non elected species (the prior art used in rejecting the elected species is not enough to reject the non elected species). The examiner must conduct another search and rely on

different reference for the non elected species. Therefore, there present a serious burden for the examiner if restriction is not being made.

The requirement is still deemed proper and is therefore made FINAL.

***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 2, 6, 7, 11, 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation of "a service center server to provide automated maintenance for the printer over the network, is subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

***Claim Rejections - 35 USC § 103***

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 6, 7, 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al (US 6,301,012) in view of Petteruti et al (US 6,379,058).

Regarding claim 6: White teaches a connecting method for automatically (column 2, lines 5-10) connecting a connection source (printer 55, fig. 12) over a network (column 3, lines 30-32) to a predetermined connection destination (print server 20, fig. 1) using a trigger signal (reply packet, column 3, lines 38-45) issued upon initial power-up (fig. 2 is program steps being run by the printer during power up) wherein the connection source is a printer and the predetermined connection destination is a service center server to provide automated maintenance (column 4, lines 60-65) for said printer over said network the method comprising the steps of: causing said connection source to make a connection request (reply packet, column 3, lines 39-46) to said predetermined connection destination, said connection request including a connection source identification for identifying said connection source, causing said predetermined connection destination to receive said connection request from said connection source in order to judge whether said connection source is a predetermined connection source or not upon interpreting said connection request (fig. 1, column 3, lines 45-55), the predetermined connection destination including plural connection source identifications for identifying a plurality of connection sources (entry for printer in cash, column 3, lines

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50-55, column 1, lines 30-45, list of devices, a printer is one of the device); the predetermined connection destination judging whether said connection source is a predetermined connection source by checking said connection source identification against said plural connection source identifications (column 3, lines 45-57), if said connection source is judged to be a predetermined connection source by said judging means, then granting connection permission to said connection source (column 4, lines 65-67, column 5, lines 1-8), and connecting (once the printer drive is installed, the printer is connected to the server to be used by users) said connection source to said predetermined connection destination.

White does not teach setting information about said predetermined connection destination to said connection source in advance.

However, White teaches the reply packet to send over the network using multicast (column 3, lines 39-40).

Petteruti, teaches packet send by multicast over the network inherently requires information about said predetermined connection destination such that the receiving party would know the packet is intended for receiving party (column 6, lines 50-60, fig. 5).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified White to include: setting information about said predetermined connection destination to said connection source in advance.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified White by the teaching of Petteruti because it

would have allowed White to include the destination address in the reply packet such that the server would determine whether the packet is intended for the server or not as taught by fig. 5 of Petteruti.

Note: White receives many signal from the network such as signal from a client computer and only the signal from a reply packet of the printer would grant permission for the connecting service such as adding printer drive for the printer or adding the printer to the network such that the printer would be selected by a user (column 3, lines 45-60, column 4, lines 60-65, column 4, lines 17-28).

Regarding claims 1, 11: Claims 1, 11 are rejected based on the same reason because claims 1, 6, 11 are generic, applicant's reply filed on 6/23/2006. Also see MPEP 806.04 (d).

Regarding claims 2, 7, 12: White teaches wherein said connection source is connected to the connection destination without intervention of an Internet service provider being contracted (fig. 1).

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1, 2, 6, 7, 11, 12 have been considered but are moot in view of the new ground(s) of rejection.

Please see detailed office action.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 26, 2006



KING Y. POON  
PRIMARY EXAMINER